

Appl. No. : **10/648,686**
Filed : **August 25, 2003**

REMARKS

Claims 29-32 have been canceled. Applicant maintains that the cancellation of a claim makes no admission as to its patentability and reserves the right to pursue the subject matter of the cancelled claim in this or any other patent application. Claims 1, 4 and 10 have been amended to recite "wherein said head portion and said razor blade are configured to permit shaving hair." Support for these amendments can be found throughout the specification, for example, at paragraphs [0019], [0031], and [0036]. Claims 1 and 4 are amended to recite "wherein said second and third axes intersect at a single point and form a fixed extension angle" and to describe the extension angle "wherein said extension angle is defined by line segments extending from the intersection of said second and third axes along portions of said second and third axes that lie in said middle and upper longitudinal portions of said handle, wherein the extension angle faces the front of the razor." Support for these amendments can be found throughout the specification as filed, for example, paragraph [0029] and Figure 6.

Similarly, claims 1 and 4 are amended to define the contour angle "wherein said contour angle is defined by line segments extending from the intersection of said first and second axes along portions of said first and second axes that lie in said lower and middle longitudinal portions of said handle, wherein the contour angle faces the front of the razor." Support for these amendments can be found throughout the specification as filed, for example, paragraph [0028] and Figure 6. Claims 2 and 11 are amended to recite "wherein said head portion is disposable." Support for these amendments can be found throughout the specification as filed, for example, paragraph [0020].

New claims 33-37 are added. Support for these claims can be found throughout the specification as filed, for example, the claims as originally filed.

Applicant acknowledges the PTO's withdrawal of the indefiniteness rejection of the pending claims.

Claims 1-8, 10-12, 15, 21-28 and 33-37 are presented for examination. Applicant responds below to the specific rejections raised by the PTO in the Office Action mailed December 11, 2006. For the reasons set forth below, Applicant respectfully traverses.

Appl. No. : **10/648,686**
Filed : **August 25, 2003**

Rejection under 35 U.S.C. §102(b) – Anticipation

The PTO has rejected claims 1, 4, 7, 8, 21, 27, 29-32 under 35 U.S.C. §102(b) as being anticipated by Heller (4,700,477) as illustrated in Appendix A of the Office Action. Applicant respectfully traverses.

Claims 1, 4, 7, 8, 21, and 27

In rejecting claims 1, 7, 8, and 21 the PTO states that angle 105 of Appendix A is the contour angle, and that it is less than 180 degrees. In rejecting claims 4 and 27, the PTO states that “the first and second axes form a fixed contour angle that is less than 180° (160).” Presumably, the PTO meant angle 105, not angle 106, of Appendix A, since angle 106 is formed by what the PTO identifies as the first and third axes.

Applicant notes that claims 1 and 4 have been amended to recite “wherein said contour angle is defined by line segments extending from the intersection of said first and second axes along portions of said first and second axes that lie in said lower and middle longitudinal portions of said handle, wherein the contour angle faces the front of the razor.”

Applicant does not concede that Heller discloses a lower, middle, and upper portion of a handle extending along longitudinal axes as labeled by the PTO in Appendix A. However, even if one assumes that Heller discloses a lower, middle, and upper handle portion with longitudinal axes as labeled by the PTO, the contour angle of Heller when properly identified is greater than 180 degrees. This is illustrated in Figure 1 below, where the lower and middle axes identified by the PTO form contour angle C.

Appl. No. : 10/648,686
Filed : August 25, 2003

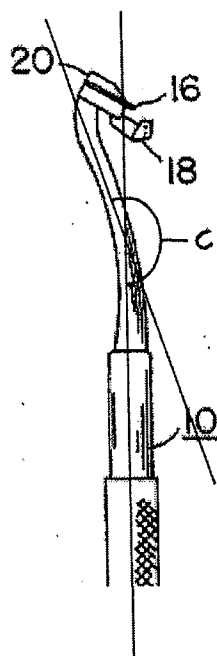


Figure 1

Because the contour angle of Heller based on the axes identified by the PTO is not less than 180 degrees as recited in claims 1 and 4, Heller does not anticipate either of these claims or any claim which depends therefrom. Therefore, Applicant respectfully requests that, for at least this reason, the PTO reconsider and withdraw the rejection of claims 1, 4, 7, 8, 21, and 27 as anticipated by Heller.

In addition to the above difference between Heller and pending claims 1 and 4, Applicant notes that as amended, independent claims 1 and 4 recite “wherein said extension angle is defined by line segments extending from the intersection of said second and third axes along portions of said second and third axes that lie in said middle and upper longitudinal portions of said handle, wherein the extension angle faces the front of the razor.” Given the placement of axes A and B by the PTO in Appendix A, to the extent that Heller discloses an upper and middle handle portion, a point Applicant does not concede, the extension angle (B) is greater than 90 degrees, as is shown in Figure 2 below.

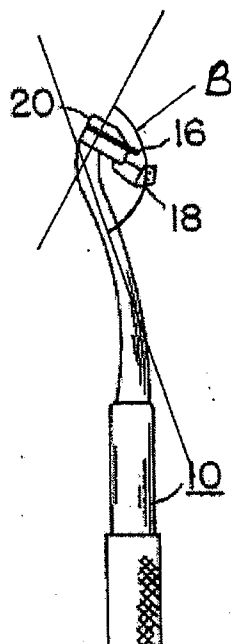


Figure 2

Pending claim 1 recites “wherein said second and third axes intersect at a single point and form a fixed extension angle that is less than or equal to ninety degrees.” Because the extension angle of Heller is not less than or equal to ninety degrees as recited in claim 1, Heller does not anticipate this claim or any claim which depends therefrom. Therefore, Applicant respectfully requests that, for at least this additional reason, the PTO reconsider and withdraw the rejection of claims 1, 7, 8, and 21, as anticipated by Heller.

Finally, Applicant notes that claims 1 and 4 have been amended to recite “wherein said head portion and said razor blade are configured to permit shaving hair.” As such, the device of claims 1, and 4, as well as claims dependent therefrom, must be configured to shave hair, not simply cut or trim hair. Shaving is distinct from merely trimming or cutting hair where a portion of the hair remains. A device which is adapted for trimming hair is not suitable for shaving, as it leaves hair stubble, an objectionable result where shaving the hair is desired. The claimed invention is configured for detailed shaving of areas such as the bikini area or eyebrows, or for shaving designs into the hair of areas such as the scalp or beard, uses which clearly requires cutting the hair as close to the root as possible. For example, hair stubble in the bikini area would be irritating and uncomfortable, and hair stubble around the eyebrows would be unsightly. As such, the claimed invention must be able to sever the hair from a body part close to the root.

Appl. No. : 10/648,686
Filed : August 25, 2003

The “Eyebrow Trimmer” disclosed by Heller is described throughout the specification as a “trimmer.” *See, e.g.*, col. 1, line 2, col. 2, lines 16-17, 22, and 54. The “front razor head guard” disclosed by Heller prevents the use of the Heller device for anything other than trimming, since it is intended to prevent the blade from contacting the skin, as is required when shaving. For this reason, the Heller does not disclose a device “wherein said head portion and said razor blade are configured to permit shaving hair,” as required by all of the claims. Therefore, Applicant respectfully requests that, for at least this additional reason, the PTO reconsider and withdraw the rejection of claims 1, 4, 7, 8, 21, and 27 as anticipated by Heller.

Rejection under 35 U.S.C. §103(a) – Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) must teach or suggest all the claim limitations. *See In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); *M.P.E.P.* § 2143 (8th ed. 2004).

Claims 2 and 3

The PTO rejects claims 2 and 3 under 35 U.S.C. § 103(a) as being unpatentable over a combination of Heller in view of Heinrich (2,139,680). The PTO states that Heller discloses the invention but fails to disclose a replaceable head portion, which Heinrich discloses. Applicant respectfully disagrees.

Claims 2 and 3 depend from claim 1. For the reasons discussed above with respect to the §102(b) anticipation rejection of claim 1, Heller does not disclose the invention of claim 1. Specifically, without conceding that Heller discloses a lower, middle, and upper portion of a handle extending along longitudinal axes as labeled by the PTO in Appendix A, the contour angle of Heller identified by the PTO is not less than 180 degrees, the extension angle identified by the PTO is not less than or equal to 90 degrees, and the head portion and razor blade are not configured to permit shaving hair. Heinrich does not supply any of these missing elements, nor does Heinrich disclose a disposable head as recited in claim 2, nor a pivotally mounted head

Appl. No. : **10/648,686**
Filed : **August 25, 2003**

portion as recited in claim 3. Applicant invites the PTO to direct the Applicant to the disclosure in Heinrich of either a disposable head or a pivotally mounted head.

Thus, the combination of Heller and Heinrich fails to disclose or suggest each and every element of claims 2 and 3, and the PTO has failed to establish a *prima facie* case of obviousness. Applicant therefore respectfully requests that, for at least these reasons, the PTO reconsider and withdraw the rejection of claims 2 and 3 as obvious over Heller in light of Heinrich.

Claims 5 and 6

The PTO rejects claims 5 and 6 under 35 U.S.C. § 103(a) as being unpatentable over a combination of Heller in view of Carreker (4,461,078). The PTO states that Heller discloses the invention, but fails to disclose a length of the upper longitudinal portion is greater than the width of the head portion and a second razor blade. The PTO argues that Carreker teaches that it is old and well known for miniature grooming shaving heads to incorporate the missing elements. Applicant respectfully disagrees.

Claims 5 and 6 depend from claim 1. For the reasons discussed above with respect to the §102(b) anticipation rejection of claim 1, Heller does not disclose the invention of claim 1. Specifically, without conceding that Heller discloses a lower, middle, and upper portion of a handle extending along longitudinal axes as labeled by the PTO in Appendix A, the contour angle of Heller identified by the PTO is not less than 180 degrees, the extension angle identified by the PTO is not less than or equal to 90 degrees, and the head portion and razor blade are not configured to permit shaving hair. Carreker does not supply any of these missing elements.

In addition, Carreker does not disclose a device where “a length of said upper longitudinal portion is greater than said width of said head portion.” To the extent that Carreker discloses an “upper longitudinal portion,” it would have to be the curved portion of the handle 12 attached to the head 20 shown in Figure 3. As a comparison of Figures 2 and 3 make clear, the length of the curved portion of 12 is not greater than the width of the head 20.

Finally, Applicant cannot conceive of any motivation for one of skill in the art to place the razor head and curved portion of the Carraker handle 12, on a portion of the handle disclosed by Heller. The PTO has not pointed to any portion of the cited references or the knowledge of one of skill in the art as providing a motivation to combine the devices of Heller and Carraker to

Appl. No. : **10/648,686**
Filed : **August 25, 2003**

derive the claimed device. Instead, the PTO is impermissibly using the Applicant's disclosure as a hindsight guide for combining the references.

Because the combination of Heller and Carraker fails to disclose or suggest each and every element of claims 5 and 6, and the PTO has failed to provide a motivation to combine the references, the PTO has failed to establish a *prima facie* case of obviousness. Applicant therefore respectfully requests that, for at least these reasons, the PTO reconsider and withdraw the rejection of claims 5 and 6 as obvious over Heller in light of Carraker.

Claims 22 and 28

The PTO rejects claims 22 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Heller. The PTO states that Heller discloses the invention but fails to disclose a head portion that is equal to or less than 1/8 inch wide. However, the PTO argues that Heller's disclosure of a width of approximately 3/16-1/4 inch is near 1/8, and it would have been obvious for one of skill in the art to modify Heller to make a head portion equal to or less than 1/8 inch. Applicant respectfully disagrees.

Claims 22 and 28 depend from claims 1 and 4. For the reasons discussed above with respect to the §102(b) anticipation rejection of claims 1 and 4, Heller does not disclose the invention of claims 1 or 4. Specifically, without conceding that Heller discloses a lower, middle, and upper portion of a handle extending along longitudinal axes as labeled by the PTO in Appendix A, the contour angle of Heller identified by the PTO is not less than 180 degrees, the extension angle identified by the PTO is not less than or equal to 90 degrees, and the head portion and razor blade are not configured to permit shaving hair. Thus, even if one of skill in the art would be motivated to modify the head of Heller to be equal to or less than 1/8 inch, a point Applicant does not concede, the modified device of Heller fails to disclose or suggest each and every element of claims 22 and 28, and the PTO has failed to establish a *prima facie* case of obviousness. Applicant therefore respectfully requests that, for at least these reasons, the PTO reconsider and withdraw the rejection of claims 22 and 28 as obvious over Heller.

Claims 10 and 23

The PTO rejects claims 10 and 23 under 35 U.S.C. § 103(a) as being unpatentable over a combination of Heller in view of Lamb (Des. 169,147). The PTO states that Heller discloses the

Appl. No. : **10/648,686**
Filed : **August 25, 2003**

invention, but fails to disclose an ergonomically shaped handle and the handle portion has a front perspective that is substantially hour-glass in shape. The PTO argues that Lamb teaches that it is old and well known in the art of razor handles to incorporate an ergonomically shaped handle and the handle portion has a front perspective that is substantially hour-glass shaped. Applicant respectfully disagrees.

First, Applicant notes that, for the reasons discussed above with respect to the §102(b) anticipation rejection of claims 1 and 4, Heller does not disclose the invention of claims 10 and 23 because the head portion and razor blade are not configured to permit shaving hair.

Second, the PTO has not provided any motivation to combine the handle of Lamb with the head portion of Heller. In fact, Heller teaches away from the combination. Heller states that “the principle prior art in the field of developing an eyebrow trimmer has been the man’s safety razor,” but one of the problems with using a standard safety razor to trim eyebrows is that the large blades prevent accurate trimming. *See Heller* at col. 1, lines 29-36. Thus, because Heller has identified the prior art of standard safety razors as inadequate for solving the problem of trimming eyebrows, one of skill in the art following the teachings of Heller would not look to a standard safety razor handle like Lamb to modify the device of Heller.

In addition, the combination of the small head and razor of Heller on the handle of Lamb would render the device of Heller inoperable for its intended purpose of trimming eyebrows because the large bulbous end of the Lamb handle would obscure the small head of Heller, and the user would not be able to accurately trim the eyebrows.

Because the combination of Heller and Lamb fails to disclose or suggest each and every element of claims 10 and 23, there is no motivation to combine the references, and the resulting device is inoperable, the PTO has failed to establish a *prima facie* case of obviousness. Applicant therefore respectfully requests that, for at least these reasons, the PTO reconsider and withdraw the rejection of claims 10 and 23 as obvious over Heller in light of Lamb.

Claims 11 and 12

The PTO rejects claims 11 and 12 under 35 U.S.C. § 103(a) as being unpatentable over a combination of Heller in view of Lamb and further in view of Heinrich. The PTO argues that Heller and Lamb disclose the invention of claim 10, but fail to disclose a replaceable head

Appl. No. : **10/648,686**
Filed : **August 25, 2003**

portion and a head portion pivotally mounted on the handle portion. Applicant respectfully disagrees.

First, Applicant notes that claims 11 and 12 depend from claim 10. Applicant asserts that Heller and Lamb do not disclose the invention of claim 10 for the reasons discussed above. Thus, even if Heinrich disclosed a replaceable head portion and a head portion pivotally mounted on the handle portion, the combined device would not disclose or suggest each and every element of claims 11 and 12.

Second, Heinrich does not disclose a disclose a disposable head portion nor a head portion that is pivotally mounted. The head portion of Heinrich is threaded onto the handle, it is not pivotally mounted. The blade portion of Heinrich is removable, but nothing in Heinrich teaches that the blade holder 21 and head portion 10 are disposable.

Because the combination of Heller, Lamb and Heinrich fails to disclose or suggest each and every element of claims 11 and 12, the PTO has failed to establish a *prima facie* case of obviousness. Applicant therefore respectfully requests that, for at least these reasons, the PTO reconsider and withdraw the rejection of claims 11 and 12 as obvious over Heller in light of Lamb and Heinrich.

Claim 15

The PTO rejects claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Heller in view of Lamb and Carreker. The PTO argues that Heller and Lamb disclose the invention of claim 10, but fail to disclose a second razor blade, which Carreker teaches is old and well known. Applicant respectfully disagrees.

Claim 15 depends from claim 10. Applicant asserts that Heller and Lamb do not disclose the invention of claim 10 for the reasons discussed above. Thus, even if Carreker disclosed a second razor blade, the combined device would not disclose or suggest each and every element of claim 15.

Because the combination of Heller, Lamb and Carreker fails to disclose or suggest each and every element of claim 15, the PTO has failed to establish a *prima facie* case of obviousness. Applicant therefore respectfully requests that, for at least these reasons, the PTO reconsider and withdraw the rejection of claim 15 as obvious over Heller in light of Lamb and Carreker.

Appl. No. : **10/648,686**
Filed : **August 25, 2003**

Claim 24

The PTO rejects claim 24 under 35 U.S.C. § 103(a) as being unpatentable over Heller in view of Lamb. The PTO states that Heller and Lamb disclose the invention but fail to disclose a head portion that is equal to or less than 1/8 inch wide, but that such modification of Heller would have been obvious. Applicant respectfully disagrees.

Claim 24 depends from claim 10. Applicant asserts that Heller and Lamb do not disclose the invention of claim 10 for the reasons discussed above. Thus, even if one of skill in the art would be motivated to modify the head of Heller to be equal to or less than 1/8 inch, a point Applicant does not concede, the modified device of Heller and Lamb fails to disclose or suggest each and every element of claim 24, and the PTO has failed to establish a *prima facie* case of obviousness. Applicant therefore respectfully requests that, for at least these reasons, the PTO reconsider and withdraw the rejection of claim 24 as obvious over Heller and Lamb.

PTO's Response to Applicant's Arguments

The PTO argues that angles A1, A2, A3 and A4 of Appendix B are control angles, that the claims only disclose that the first and third axes form a fixed control angle with no specifics to a specific angle, and therefore in Appendix A, items 103 and 106 are both control angles. Similarly, all of the angles created by these intersections are all equally considered contour and extension angles.

Applicant has amended the claims to clarify which of the angles identified by the PTO are the angles recited in the claims.

Appl. No. : 10/648,686
Filed : August 25, 2003

CONCLUSION

In view of the above, Applicant respectfully maintains that claims are patentable and request that they be passed to issue. Applicant invites the Examiner to call the undersigned if any remaining issues may be resolved by telephone.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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